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APPEAL BRIEF

Applicant	:	Jonathan Leblang
App. No	:	10/748,745
Filed	:	December 30, 2003
For	:	COMPUTER CONTROLLED ARTICLE CLASSIFICATION AND PROCESSING SYSTEM
Examiner	:	Tonya S. Joseph
Art Unit	:	3628

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant, Applicant in the above-captioned patent application, appeal the final rejection of claims 1-13 and 50-62 set forth in the Final Office Action issued on March 23, 2009 (hereinafter "the Final Office Action").

   In accordance with the Notice of Appeal filed, Appellant submits this Appeal Brief.

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I. REAL PARTY IN INTEREST

The real party in interest in the present application is Amazon Technologies, Inc., the assignee of the present application.

II. RELATED APPEALS AND INTERFERENCES

No related appeals, interferences, or court proceedings are currently pending.

III. STATUS OF CLAIMS

Claims 1-13 and 50-62 are currently pending in the application and are the subject of this appeal. Claims 14-49 are canceled. The pending claims are listed as an appendix.

IV. STATUS OF AMENDMENTS

No amendments have been made in response to the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present application includes two independent claims. Each independent claim is summarized below, with citations to corresponding portions of the specification and drawings as required by 37 C.F.R. § 41.37(c)(1)(v). These citations illustrate specific examples and embodiments of the recited claim language, and do not limit the claims.

Claim 1

Claim 1 is directed to an article processing system (*see, e.g.,* ¶¶ 0004; 0017; Fig. 1A)

The article processing system includes at least:

- a database that stores article identification information and article location information for a plurality of articles; (*see, e.g.,* item 104B in Fig. 1B; lines 7-10 of ¶ 0034)

- a first module that determines at least a shipment date when a pending user order is to be shipped, wherein the pending order was placed via a computer network

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during a first network session; (*see, e.g.,* item 102A in Fig. 1A; item 108B in Fig. 1B; lines 1-13 of ¶ 0035)

- a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order; (*see, e.g.,* item 102A in Fig. 1A; item 102B in Fig. 1B; lines 1-14 of 0035) and

- a third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment (*see, e.g.,* item 102A in Fig. 1A; lines 5-7 of ¶ 0020; lines 1-6 of ¶ 0023; lines 1-11 of ¶ 0025).

Claim 50

Claim 50 is directed to an article order processing apparatus stored on a computer readable medium, the article order processing apparatus comprising instructions configured to be executed by a computing device in order to perform the method including at least the following:

- identifying a shipment date when a pending user order is to be shipped (*see, e.g.,* item 306 in Fig. 3; lines 2-4 of ¶ 0004; lines 6-7 of ¶ 0042);

- based at least in part on information retrieved from a database that stores article identification information and article location information for a plurality of articles, identifying a first article that can be added to the pending order without delaying the shipment date of the pending order (*see, e.g.,* item 307 in Fig. 3; lines 2-4 of ¶ 0004; lines 10-16 of ¶ 0042); and

- providing a notification for the user that indicates that the user can add the first article to the pending order without delaying the pending order shipment date (*see, e.g.,* item 308 in Fig. 3; lines 2-4 of ¶ 0004; lines 1-13 of ¶ 0043).

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are to be reviewed on appeal:

- The rejection of Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59, and 61-62 under 35 USC 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2002/0077929 to Knorr.

- The rejection of Claims 2 and 51 under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2004/0260710 to Marston et al.

- The rejection of Claims 4 and 53 under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2003/0097311 to Shinohara et al.

- The rejection of Claims 5 and 54 under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2005/0021664 to Shmukler et al.

- The rejection of Claims 8, 11, 57, and 60 under 35 USC 103(a) over Knorr in view of Official Notice.

- The rejection of Claims 7 and 56 under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2003/0130903 to Silverbrook et. al.

All of the claims that are not separately argued properly stand or fall with the respective claims from which they depend.

Appellants reserve the right to disqualify one or more of the applied references as "prior art" in the future.

VII. ARGUMENT

For the reasons explained below, Appellant respectfully submits that all of the grounds for rejection are improper. By declining to present arguments in connection with certain claims and claim recitations, Appellant does not imply that these claims and claim recitations are disclosed or rendered obvious by the cited art.

1. Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59, and 61-62 are not anticipated by Knorr

Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59, and 61-62 stand rejected under 35 USC 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2002/0077929 to Knorr.

Claims 1 and 50 are the sole independent claims in this group. Claims 3, 6, 9-10, 12-13 depend from Claim 1. Claims 52, 55, 58-59, and 61-62 depend from Claim 50.

The rejection is also improper because, as set forth below, Knorr does not explicitly or inherently disclose all of the elements of any claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Net Moneyin v. Verisign, Inc.* No. 07-1565 at 15 (Fed. Cir. Oct. 20, 2008), citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

Independent Claim 1

Claim 1 reads as follows, which highlighting of language pertinent to the discussion:

1. An article processing system, comprising:

a database that stores article identification information and article location information for a plurality of articles;

a first module that determines at least a shipment date when a pending user order is to be shipped, wherein the pending order was placed via a computer network during a first network session;

a second module that, **based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order; and**

a third module that causes **a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment.**

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The rejection of Claim 1 is improper at least because Knorr does not disclose, implicitly or inherently, first or second modules capable of operating as defined in the claim. The Final Office Action relies on the paragraphs 65 of Knorr in connection with this feature (Final Office Action pages 7 and 8). The referenced portions of Knorr describe an order pending shopping cart that can be changed by the purchaser.

In particular, the only portion of Knorr, paragraph 65, that involves suggesting items to a user with respect to a pending order is highlighted below:

> "[0065] FIG. 9B shows the next portion of the timeline, long term monitoring mode 606, including purchaser path 502, electronic vendor path 506, with the database path being bifurcated at 529 into an order pending database path for purchasers 504A and an order pending database path for electronic vendors 504B. In the purchaser path at 540, the purchaser may optionally input instructions about shipping, consolidating item requests, special handling, or other changes at any time during the monitoring mode. The order pending shopping cart may also be cancelled or modified anytime during the monitoring mode. As indicated in the order pending database path at 542, the order pending database holds the information for the order pending shopping cart for that event. The data in the order pending database is fluid or variable at this point and may be changed by the purchaser. As indicated in the order pending database path for electronic vendor at 544, selection in the order pending shopping cart can be processed and updated in batch mode, for example, at night, for access by the electronic vendor(s) who had transactions complete during the prior day. **As indicated in the electronic vendor path at 546, the vendor can use the time between the electronic hold and the ultimate order execution to plan inventory and interact with the purchaser for suggestive sellings, i.e., up-selling and or cross-selling.** Other suggestive selling opportunities may be afforded in conjunction with the logistics assurance modality discussed earlier. For example, in the event of product unavailability, an alternate or suitable substitute product may be presented to the purchaser, or in suitable cases, the recipient. For example, this opportunity may arise with regard to new model replacement of an outdated model of an item." (Knorr, paragraph [0065], emphasis added)

Nothing in this or any other portion of Knorr suggests identifying articles that could be added to a pending order **without delaying shipment** of the pending order. Indeed, Knorr is **completely silent regarding determining the possible effect on a shipping date with respect to suggesting adding an article to a pending order**. There is nothing that indicates the ultimate execution date referred to in paragraph 65 cannot or will not be delayed. Further, nothing in this or any other portion of Knorr suggests that a notification is provided for the user that indicates that the user can add an article to a pending order without delaying the pending

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order shipment date. Indeed, the use of the phrase "ultimate," which modifies "order execution," seems to imply that "order execution" may be postponed, until finally there is an "ultimate order execution." Otherwise, there would be no need for the phrase "ultimate."

The Final Office Action, at pages 2-3, further alleges that because Knorr makes no mention of halting or delaying shipping as a result of the addition of suggested items, "one can reason" that "Knorr tries to cross-sell a customer before the order is shipped further supports the Final Office Action's conclusion that the addition of items is 'without delaying the shipment date of the pending order.'" However, merely because Knorr fails to discuss whether adding a suggested item to a pending order will alter a shipping date does not mean that Knorr discloses identifying an article that can be added to a pending order without delaying the pending order shipment date. The Office Action fails to point to any language in Knorr which states that such a determination takes place.

Indeed, Knorr's **failure to even discuss determining whether adding a suggested item to a pending order will alter a shipping date** is further evidence that Knorr is not concerned with identifying articles that could be added to a pending order without delaying shipment of the pending order or with providing a user notification that indicates that the user can add an identified article to a pending order without delaying the pending order shipment date.

It is not clear if the Final Office Action, in stating that "one can reason the fact that Knorr tries to cross-sell a customer before the order is shipped further supports the Final Office Action's conclusion that the addition of items is 'without delaying the shipment date of the pending order,'" is alleging that it is inherent in Knorr's disclosure of a vendor being able to use the time between the electronic hold and the ultimate order execution to interact with the purchaser for suggestive sellings, that the system of Knorr identifies a first article that can be added to the pending order without delaying the shipment date of the pending order. If such allegation of inherency is being made, Appellant traverses such allegation. The system of Knorr could, for example, suggest an article prior to an pending order execution date whose addition to a pending order would result in the delay of the order execution date (even if the original order execution date has not yet occurred) or of the actual order shipping date (even if the original shipping date has not yet occurred), to allow the original article and the added article to be shipped together at a later date to reduce shipping costs.

Still further, even assuming that the Final Office Action's allegation that Knorr could be read to disclose "a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order," (which allegation Appellant specifically denies), the following feature would still be completely absent from Knorr: "a third module that causes a notification to be presented to the user, wherein the **notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment**".

For at least the foregoing reasons, the rejection of Claim 1 is improper.

Independent Claim 50

Claim 50 reads as follows, which highlighting of language pertinent to the discussion:

50. An article order processing apparatus stored on a computer readable medium, the article order processing apparatus comprising instructions configured to be executed by a computing device in order to perform the method of:

> identifying a shipment date when a pending user order is to be shipped;
>
> **based at least in part on information retrieved from a database that stores article identification information and article location information for a plurality of articles, identifying a first article that can be added to the pending order without delaying the shipment date of the pending order; and**
>
> **providing a notification for the user that indicates that the user can add the first article to the pending order without delaying the pending order shipment date.**

The rejection of Claim 50 is improper at least because Knorr does not disclose, implicitly or inherently, the method of identifying a first article that can be added to the pending order without delaying the shipment date of the pending order based at least in part on information retrieved from a database that stores article identification information and article location information for a plurality of articles or providing a notification for the user that indicates that the user can add the first article to the pending order without delaying the pending order shipment date.

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As similarly discussed above with respect to Claim 1, the Final Office Action relies on the paragraphs 65 of Knorr in connection with this feature (Final Office Action pages 7 and 8). The referenced portions of Knorr describe an order pending shopping cart that can be changed by the purchaser.

In particular, the only portion of Knorr, paragraph 65, that involves suggesting items to a user with respect to a pending order is recited below:

> "As indicated in the electronic vendor path at 546, the vendor can use the time between the electronic hold and the ultimate order execution to plan inventory and interact with the purchaser for suggestive sellings, i.e., up-selling and or cross-selling."

Nothing in this or any other portion of Knorr suggests identifying articles that could be added to a pending order **without delaying shipment** of the pending order. Indeed, Knorr is **completely silent regarding determining the possible effect on a shipping date with respect to suggesting adding an article to a pending order**. Further, nothing in this or any other portion of Knorr suggests that a notification is provided for the user that indicates that the user can add an article to a pending order without delaying the pending order shipment date.

As discussed above with respect to Claim 1, the Final Office Action, at pages 2-3, further alleges that because Knorr makes no mention of halting or delaying shipping as a result of the addition of suggested items, "one can reason" that "Knorr tries to cross-sell a customer before the order is shipped further supports the Final Office Action's conclusion that the addition of items is 'without delaying the shipment date of the pending order.'" However, merely because Knorr fails to discuss whether adding a suggested item to a pending order will alter a shipping date does not mean that Knorr discloses identifying an article that can be added to a pending order without delaying the pending order shipment date.

Indeed, Knorr's **failure to even discuss determining whether adding a suggested item to a pending order will alter a shipping date** is further evidence that Knorr is not concerned with identifying articles that could be added to a pending order without delaying shipment of the pending order or with providing a user notification that indicates that the user can add an identified article to a pending order without delaying the pending order shipment date.

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As discussed with respect to Claim 1, it is not clear if the Final Office Action, in stating that "one can reason the fact that Knorr tries to cross-sell a customer before the order is shipped further supports the Final Office Action's conclusion that the addition of items is 'without delaying the shipment date of the pending order,'" is alleging that it is inherent in Knorr's disclosure of a vendor being able to use the time between the electronic hold and the ultimate order execution to interact with the purchaser for suggestive sellings, that the system of Knorr identifies a first article that can be added to the pending order without delaying the shipment date of the pending order. If such allegation of inherency is being made, Appellant traverses such allegation. The system of Knorr could, for example, suggest an article prior to an pending order execution date whose addition to a pending order would result in the delay of the order execution date (even if the original order execution date has not yet occurred) or of the actual order shipping date (even if the original shipping date has not yet occurred), to allow the original article and the added article to be shipped together at a later date to reduce shipping costs.

Still further, even assuming that the Final Office Action's allegation that Knorr could be read to disclose "based at least in part on information retrieved from a database that stores article identification information and article location information for a plurality of articles, identifying a first article that can be added to the pending order without delaying the shipment date of the pending order," (which allegation Appellant specifically denies), the following feature would still be completely absent from Knorr: "providing a notification for the user that indicates that the user can add the first article to the pending order without delaying the pending order shipment date".

For at least the foregoing reasons, the rejection of Claim 50 is improper.

Dependent Claims 3 and 52

The rejection of Claims 3 and 52 is improper in view of the respective dependencies from Claims 1 and 50.

In addition, the rejection of Claims 3 and 52 is improper because Knorr fails to expressly or inherently disclose the features of "wherein the third module causes the notification to be presented to the user at least partly in response to determining that the user is accessing the

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computer network" or of "wherein the apparatus is configured to provide the notification to the user at least partly in response to determining that the user is accessing a first web site".

Because Knorr does not disclose providing the notification of Claim 1 (wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment) or Claim 50, Knorr does not expressly or inherently disclose providing the notification as claimed. Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 3 and of Claim 52, Knorr cannot anticipate Claims 3 and 52.

For at least the foregoing reasons, the rejection of Claims 3 and 52 is improper.

<u>Dependent Claims 6 and 55</u>

The rejection of Claims 6 and 55 is improper in view of the respective dependencies from Claims 1 and 50.

In addition, in rejecting Claims 6 and 55 as being anticipated by Knorr, the Final Office Action argues that Knorr, at paragraph 42, discloses wherein the notification includes an order incentive. For reference, paragraph 42 of Knorr is reproduced below:

[0042] In some methods, the event profile data elements are obtained directly from the recipient or the purchaser, for example, by keying into the order pending application. In some situations, a third-party database, such as a PDA database or electronic address book can be the electronic source of the event information. A recipient profiling step 36 may be executed to obtain information about the intended item recipient. The recipient profile information can include name, address(es), phone, age, gender, gift preferences, and/or catalogs of special dates associated with that particular recipient, or other information. In a business-to-business environment, the recipient identifier information can include company name, contact name, SIC code, product/service categories or other information. The recipient profiling data points obtained in step 36 may be obtained directly from the recipient or the purchaser by keying into the order pending application. In some situations, a third-party database such as a PDA database or electronic address book can be the electronic source of the event information. In conjunction with the interface to a third-party database, e.g., a PDA or PC calendar or scheduler such as Microsoft®. Outlook®., information from the order pending database may execute certain events within the third-party scheduler. For example, a purchaser or potential purchaser may be presented with an array of events entered in their scheduler for which they may wish to pend an order with the order pending database. Based on this body of events, periodic reminders of events for which no order is pended may be presented to the purchaser to suggest pending an order, or even suggesting suitable items pertinent to widely-recognized events such as holidays, perhaps with regard to certain individuals from the

purchaser's personal individual contacts database. Alternatively, existing pending orders may be shown, e.g., with an icon or thumbnail picture of a selected item, in conjunction with upcoming events in the personal scheduler of the purchaser. This may be linked to suggestive selling or upgrading solicitations or inducements, e.g., special offers or coupons.

Although paragraph 42 of Knorr discloses providing inducements, because Knorr does not disclose providing the notification of Claim 1 (wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment) or Claim 50, Knorr does not expressly or inherently disclose providing such a notification, further including an order incentive order, as claimed. Therefore, Knorr fails to include the feature of providing an inducement in a notification indicating that the user can add at least a first article to the pending order without delaying the pending order shipment.

Because Knorr fails to inherently or explicitly disclose at least one element of Claim 6 and of Claim 55, Knorr cannot anticipate Claims 6 and 55. For at least the foregoing reasons, the rejection of Claims 6 and 55 is improper.

Dependent Claims 9 and 58

The rejection of Claims 9 and 58 is improper in view of the respective dependencies from Claims 1 and 50.

Dependent Claims 10 and 59

The rejection of Claims 10 and 59 is improper in view of the respective dependencies from Claims 1 and 50. Further, the Final Office Action alleges that paragraph 65 of Knorr teaches wherein the first article is identified based in part on user history order information retrieved from the database. However, a careful reading of the citation relied upon by the Final Office Action fails to disclose the foregoing elements. While Knorr refers to a pending order database and to suggestive selling, the citation relied upon by the Final Office Action does not expressly or inherently disclose that the suggestive selling of Knorr involves identifying an article that can be added to the pending order based in part on user history order information retrieved from a database, much less the invention as claimed.

Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 10 and of Claim 59, Knorr cannot anticipate Claims 10 and 59. For at least the foregoing reasons, the rejection of Claims 10 and 59 is improper.

Dependent Claims 12 and 61

The rejection of Claims 12 and 61 is improper in view of the respective dependencies from Claims 1 and 50.

Further, the Final Office Action alleges that paragraphs 42 and 65 of Knorr teach wherein the first article is identified based in part on user preference information retrieved from the database. However, with respect to preferences, paragraph 42 merely refers to a recipient profile, and **makes no mention of preferences with respect to the user** that is placing the order, per Claims 12 and 61. Further, a careful reading of paragraph 65 fails to disclose any mention of identifying an article based on user preference information retrieved from a database.

Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 12 and of Claim 61, Knorr cannot anticipate Claims 12 and 61. For at least the foregoing reasons, the rejection of Claims 12 and 61 is improper.

Dependent Claims 13 and 62

The rejection of Claims 13 and 62 is improper in view of the respective dependencies from Claims 1 and 50.

Further, the Final Office Action alleges that paragraphs 42 and 65 of Knorr teach wherein the notification is provided to the user after the pending order was placed. However, a careful reading of the citation relied upon by the Final Office Action fails to disclose the foregoing elements. Indeed, because Knorr fails to even provide a notification that indicates that the user can add at least the first article to the pending order without delaying the pending order shipment, as discussed with respect to Claim 1, Knorr further fails to expressly or inherently disclose providing such notification to the user after the user's pending order is placed.

Therefore, because Knorr fails to inherently or explicitly disclose at least one element of Claim 13 and of Claim 62, Knorr cannot anticipate Claims 12 and 61. For at least the foregoing reasons, the rejection of Claims 13 and 62 is improper.

Claims 2 and 51 are not obvious over Knorr in view of Marston

Claims 2 and 51 stand rejection under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2004/0260710 to Marston.

The rejection of Claims 2 and 51 is improper in view of the respective dependencies from Claims 1 and 50.

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Further, in rejecting Claims 2 and 51, the Final Office Action admits that Knorr fails to disclose wherein the notification is an icon displayed via a toolbar on a user terminal. However, the Final Office Action alleges that Marston discloses the missing elements. The Office Action further alleges that it "would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Marston to alert a user of a change in a system."

However, because neither reference discloses providing any type of notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment, even if Knorr were modified with the icon of Marston, the result would still fail to provide such a notification as an icon displayed via a toolbar on a user terminal. Instead, combining Martson with Knorr as proposed by the Final Office Action would merely result in alerting a user of a change in the system.

Further, the Final Office Action has failed to articulate a clear rational for modifying Knorr with the icon of Martson. Instead, the Final Office Action improperly relies on a conclusory statement. For example, the Final Office Action fails to demonstrate or even allege that the results of the proposed modification would have been predictable to one of ordinary skill in the art. As stated in MPEP § 2141.I, "[w]hen considering obviousness of a combination of known elements, the operative question is thus 'whether the improvement is more than the predictable use of prior art elements according to their established functions.' *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385."

For at least the foregoing reasons, the rejection of Claims 2 and 51 is improper.

Claims 4 and 53 are not obvious over Knorr in view of Shinohara

Claims 4 and 53 under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2003/0097311 to Shinohara et al.

The rejection of Claims 4 and 53 is improper in view of the respective dependencies from Claims 1 and 50.

Further, in rejecting Claims 4 and 53, the Final Office Action admits that Knorr fails to disclose wherein the notification is provided via an email transmitted to a user email address. However, the Final Office Action alleges that Shinohara discloses the missing elements. The Office Action further alleges that it "would have been prima facie obvious to one of ordinary

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skill in the art at the time of invention to modify the system of Knorr to include the teachings of Shinohara to receive the status of an ordered item."

However, the notification referred to in Claims 4 and 53 is not providing the status of an ordered item. Instead, the notification indicates that a user can add at least the first article to a pending order without delaying the pending order shipment. Therefore, even if the Knorr were combined with the teachings of Shinohara to receive the status of an ordered item as stated in the Office Action, thee result would still fail to provide a notification via email that indicates that a user can add at least the first article to a pending order. Thus, for at least this reason, the Final Office Action has failed to make a prima facie case of obviousness.

In addition, because neither Knorr nor Shinohara disclose providing any type of notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment, even if Knorr were modified with the email of Shinohara, the result would still fail to provide such an email notification that indicates that a user can add at least the first article to a pending order without delaying the pending order shipment.

Further, the Final Office Action has failed to articulate a clear rational for modifying Knorr with the icon of Shinohara. Instead, the Final Office Action improperly relies on a conclusory statement. For example, the Final Office Action fails to demonstrate or even allege that the results of the proposed modification would have been predictable to one of ordinary skill in the art. As stated in MPEP § 2141.I, "[w]hen considering obviousness of a combination of known elements, the operative question is thus 'whether the improvement is more than the predictable use of prior art elements according to their established functions.' *KSR International Co. v. Teleflex Inc.,* 550 U.S. ___, 82 USPQ2d 1385."

For at least the foregoing reasons, the rejection of Claims 4 and 53 is improper.

Claims 5 and 54 are not obvious over Knorr in view of Shmukler

Claims 5 and 54 stand rejected under 35 USC 103(a) over Knorr in view of U.S. Patent Publication No. 2005/0021664 to Shmukler et al. As an initial matter, Appellant notes that U.S. Patent Publication No. 2005/0021664 does not name Shmukler as an inventor, and does not include paragraphs 82 or 84-86, relied upon by the Office Action is rejecting Claims 5 and 54. For the purposes of the Appeal Brief, Appellant will assume that the Office Action intended to

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refer to U.S. Patent Publication No. 2005/0010857, which names Shmukler as an inventor, and which includes paragraphs 82 or 84-86.

The rejection of Claims 5 and 54 is improper in view of the respective dependencies from Claims 1 and 50.

Further, in rejecting Claims 5 and 54, the Final Office Action admits that Knorr fails to disclose wherein the notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired. However, the Final Office Action alleges that Shmukler discloses the missing elements. The Office Action further alleges that it "would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Shmukler to provide adequate order and offer information to a user."

The Office Action appears to have mischaracterized Shmukler. While Shmukler discloses a link and a notification that an offer expired, Shmukler does not disclose that a notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired.

Thus, even if the link of Shmukler were combined with Knorr, the result would still not provide a message indicating that the first amount time to add articles to the pending order has expired, as neither Knorr nor Shmukler disclose a message indicating that the first amount time to add articles to the pending order has expired.

Further, the Final Office Action has failed to articulate a clear rational for modifying Knorr with the icon of Shmukler. Instead, the Final Office Action improperly relies on a conclusory statement. For example, the Final Office Action fails to demonstrate or even allege that the results of the proposed modification would have been predictable to one of ordinary skill in the art. As stated in MPEP § 2141.I, "[w]hen considering obviousness of a combination of known elements, the operative question is thus 'whether the improvement is more than the predictable use of prior art elements according to their established functions.' *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385."

Therefore, for at least the foregoing reasons, the rejection of Claims 5 and 54 is improper.

Claims 8 and 57

The rejection of Claims 8 and 57 is improper in view of the respective dependencies from Claims 1 and 50.

In addition, in rejecting Claims 8 and 57, the Final Office Action admits that Knorr fails to disclose wherein the location information is used by the second module to determine how long it would take to transport the first article from a storage area to a packing area. Nonetheless, the Final Office Action takes Official Notice that using location information to determine transport time to an area is old and well known and asserts that it would be obvious to modify the system of Knorr to include the teachings of Official Notice to calculate an estimated shipment date. However, even if the system of Knorr were modified to include the teachings of the Final Office Action's alleged Office Notice, the result would still not use the location information to identify at least a first article that can be added to a pending order within a first amount of time without delaying the shipment date of the pending order.

Further, the Final Office Action has failed to articulate a clear rational for modifying Knorr with Official Notice. Instead, the Final Office Action improperly relies on a conclusory statement. For example, the Final Office Action fails to demonstrate or even allege that the results of the proposed modification would have been predictable to one of ordinary skill in the art. As stated in MPEP § 2141.I, "[w]hen considering obviousness of a combination of known elements, the operative question is thus 'whether the improvement is more than the predictable use of prior art elements according to their established functions.' *KSR International Co. v. Teleflex Inc.,* 550 U.S. ___, 82 USPQ2d 1385."

Thus, for at least the foregoing reasons, Appellant respectfully submits that the rejection of Claims 8 and 57 is improper.

Claims 11 and 60

In rejecting Claims 11 and 60, the Final Office Action admits that Knorr fails to disclose wherein the first article is identified based in part on the quantity of the first article in inventory in an order fulfillment center from which at least one article in the pending order is to be shipped. Nonetheless, the Final Office Action takes Official Notice that identifying an article based on a quantity available in a shipping center is old and well known and asserts that it would be obvious to modify the system of Knorr to include the teachings of Official Notice to up-sell overstocked

items. Appellant notes that neither Knorr nor Official notice are concerned with or even mention up-selling overstocked items, and so there would be no motivation to modify the system of Knorr as proposed by the Final Office Action. Further, even if the system of Knorr were modified to include the teachings of the Final Office Action's Office Notice, the result would still not use the quantity information to identify at least a first article that can be added to a pending order within a first amount of time without delaying the shipment date of the pending order.

Further, the Final Office Action has failed to articulate a clear rational for modifying Knorr with Official Notice. Instead, the Final Office Action improperly relies on a conclusory statement. For example, the Final Office Action fails to demonstrate or even allege that the results of the proposed modification would have been predictable to one of ordinary skill in the art. As stated in MPEP § 2141.I, "[w]hen considering obviousness of a combination of known elements, the operative question is thus 'whether the improvement is more than the predictable use of prior art elements according to their established functions.' *KSR International Co. v. Teleflex Inc.,* 550 U.S. ___, 82 USPQ2d 1385."

Thus, for at least the foregoing reasons, Appellant respectfully submits that the rejection of Claims 11 and 60 is improper.

Claims 7 and 56

In rejecting Claims 7 and 56, the Final Office Action admits that Knorr fails to disclose a fourth module, which, during a second network session, provides that user with an interface via which the user can add the at least first article to the pending order. Nonetheless, relies upon Silverbrook to supply the missing elements. Appellant respectfully maintains that the Final Office Action has inadvertently mischaracterized Silverbrook. While Silverbrook discloses adding an item to a pending order, it appears that the item is added during the same session as the pending order, rather than during a second network session. Further, even if the system of Knorr were modified to include the teachings of Silverbrook, the result would still not enable a user to add an article that had been identified to the user as being addable to a pending order within a first amount of time without delaying the shipment date of the pending order.

Further, the Final Office Action has failed to articulate a clear rational for modifying Knorr with Silverbrook. Instead, the Final Office Action improperly relies on a conclusory statement. For example, the Final Office Action fails to demonstrate or even allege that the

results of the proposed modification would have been predictable to one of ordinary skill in the art. As stated in MPEP § 2141.I, "[w]hen considering obviousness of a combination of known elements, the operative question is thus 'whether the improvement is more than the predictable use of prior art elements according to their established functions.' *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385."

Thus, for at least the foregoing reasons, Appellant respectfully submits that the rejection of Claims 7 and 56 is improper.

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VIII. CLAIMS APPENDIX

1. An article processing system, comprising:

a database that stores article identification information and article location information for a plurality of articles;

a first module that determines at least a shipment date when a pending user order is to be shipped, wherein the pending order was placed via a computer network during a first network session;

a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order; and

a third module that causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment.

2. The article processing system as defined in Claim 1, wherein the notification is an icon displayed via a toolbar on a user terminal.

3. The article processing system as defined in Claim 1, wherein the third module causes the notification to be presented to the user at least partly in response to determining that the user is accessing the computer network.

4. The article processing system as defined in Claim 1, wherein the notification is provided via an email transmitted to a user email address.

5. The article processing system as defined in Claim 1, wherein the notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired.

6. The article processing system as defined in Claim 1, wherein the notification includes an order incentive offer.

7. The article processing system as defined in Claim 1, further comprising a fourth module, that, during a second network session, provides that user with an interface via which the user can add the at least first article to the pending order.

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8. The article processing system as defined in Claim 1, wherein the location information is used by the second module to determine how long it would take to transport the first article from a storage area to a packing area.

9. The article processing system as defined in Claim 1, wherein the first article is identified based in part on at least one article type in the pending order.

10. The article processing system as defined in Claim 1, wherein the first article is identified based in part on user history order information retrieved from the database.

11. The article processing system as defined in Claim 1, wherein the first article is identified based in part on the quantity of the first article in inventory in an order fulfillment center from which at least one article in the pending order is to be shipped.

12. The article processing system as defined in Claim 1, wherein the first article is identified based in part on user preference information retrieved from the database.

13. The article processing system as defined in Claim 1, wherein the notification is provided to the user after the pending order was placed.

Claims 14-49 (Cancelled)

50. An article order processing apparatus stored on a computer readable medium, the article order processing apparatus comprising instructions configured to be executed by a computing device in order to perform the method of:

identifying a shipment date when a pending user order is to be shipped;

based at least in part on information retrieved from a database that stores article identification information and article location information for a plurality of articles, identifying a first article that can be added to the pending order without delaying the shipment date of the pending order; and

providing a notification for the user that indicates that the user can add the first article to the pending order without delaying the pending order shipment date.

51. The article order processing apparatus as defined in Claim 50, wherein the notification is configured to cause an icon to be displayed via a toolbar on a user terminal.

52. The article order processing apparatus as defined in Claim 50, wherein the apparatus is configured to provide the notification to the user at least partly in response to determining that the user is accessing a first web site.

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53. The article order processing apparatus as defined in Claim 50, wherein the apparatus is configured to provide the notification via an email transmitted to a user email address.

54. The article order processing apparatus as defined in Claim 50, wherein the notification includes a link, wherein if the user activates the link after a first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired.

55. The article order processing apparatus as defined in Claim 50, wherein the notification includes an order incentive offer.

56. The article order processing apparatus as defined in Claim 50, wherein the apparatus is further configured to perform the method of providing the user with an interface via which the user can add the at least first article to the pending order.

57. The article order processing apparatus as defined in Claim 50, wherein the location information is used by the apparatus to determine how long it would take to transport the first article from a storage area to a packing area.

58. The article order processing apparatus as defined in Claim 50, wherein the first article is identified based in part on at least one article type in the pending order.

59. The article order processing apparatus as defined in Claim 50, wherein the first article is identified based in part on user history order information retrieved from the database.

60. The article order processing apparatus as defined in Claim 50, wherein the first article is identified based in part on the quantity of the first article in inventory in an order fulfillment center from which at least one article in the pending order is to be shipped.

61. The article order processing apparatus as defined in Claim 50, wherein the first article is identified based in part on user preference information retrieved from the database.

62. The article order processing apparatus as defined in Claim 50, wherein the notification is provided to the user after the pending order was placed.

Claims 63-79 (Cancelled)

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IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.

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CONCLUSION

For the reasons explained above, Appellants respectfully submit that the rejections of claims 1-13 and 50-62 are improper and should be reversed.

Please charge any additional fees that may be required now or in the future to Deposit Account No. 11-1410.

Dated: July 14, 2009

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